

Remarks

Entry of the above-noted amendments, reconsideration of the application, and allowance of all claims pending are respectfully requested. By this amendment, claims 1 is amended. These amendments to the claims constitute a bona fide attempt by applicants to advance prosecution of the application and obtain allowance of certain claims, and are in no way meant to acquiesce to the substance of the rejections. Claims 1- 41 are pending.

Claim Rejections - 35 U.S.C. §103

MPEP §706.02(j) states: "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

MPEP §2143.01 states: "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved, as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

Claims 1-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (<http://www.javaworld.com/iavaworld/@04-1998/ow-04-beans p.html> (written by Johnson) and

Venners (<http://www.javaworld.com/javaworld/iw-05-1997/iw-05hood p.html>, written by Venners).

Applicants respectfully submit that the applied combination of references, assuming, *arguendo* that the modification or combination of the applied references is proper, does not teach or suggest one or more elements of the claimed invention, as further discussed below. Applicant respectfully traverses the rejections and seeks withdrawal of the rejections resulting in allowance of the application.

In claim 1, a software agent is generated at an originating host. The software agent is split into a code unit and a data unit. The data unit, but not the associated code unit, is forwarded from the originating host to the destination host. Claim 1 has been amended to include "combining, by the destination host, the data unit with a further code unit associated with the data unit, forming a destination agent, wherein the further code unit is not sourced by the originating host". The other independent claims already include this limitation.

The Examiner argued that, regarding claim 1, Venners teaches "A method comprising the steps of: generating a software agent (especially the section Concluding thoughts: Objectorientation and mobile agents, i.e., mobile agents ... aglets are Java objects)." The Examiner admits that these passages of Venners do not teach "splitting ... code unit and a data unit in the sense of the claim.

The Examiner then alleges that Johnson teaches "splitting the software agent into a code unit and a data unit; forwarding the data unit to the destination host (such as at section 3.8: "At other times, the transient keyword is used to prevent some particular variable from being included in the serialization stream for security reasons. Perhaps a password is kept as cleartext (that is, decrypted, human-readable text) within an object, but it must be encrypted when it's placed in an output stream. In any case, transient and static variables are not included in the output stream" - thereby permitting split of features such as code and data, not all which would be placed in the output stream) for the motivation of security.

The Examiner then concludes that would have been obvious to those of ordinary skill in the art at the time of the claimed invention to combine Venners and Johnson for the motivation noted in the previous paragraphs so as to teach the claimed invention.

However, one skilled in the art would not utilized Johnson to achieved the present invention as claimed in any of the present independent claim. In fact Johnson would teach away from the present invention. "An applicant may rebut a prima facie case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect. In re Geisler, 116 F.3d at 1469, 43 USPQ2d at 1365 (quoting In re Malagari, 499 F.2d at 1303, 182 USPQ at 553)."

As cited by the Examiner Johnson teaches that transient and static variables are not included in the output stream. However, Johnson provides no teaching regarding the further code unit not being sourced by the originating host. This is a claimed element of each of the independent claims. Thus, no combination of any of the cited prior art would result in the present claimed invention. In fact, combining Veneers and Johnson would teach away from the present claimed invention because Johnson teaches that both transient and static variables are not to be included in the output stream, which is not equivalent to: splitting the software agent into a code unit and a data unit; forwarding from the originating host the data unit but not the code unit to a destination host; and combining, by the destination host, the data unit with a further code unit associated with the data unit, forming a destination agent, wherein the further code unit is not sourced by the originating host.

"An applicant may rebut a prima facie case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect. In re Geisler, 116 F.3d at 1469, 43 USPQ2d at 1365 (quoting In re Malagari, 499 F.2d at 1303, 182 USPQ at 553)."

Furthermore, the above arguments apply to each of the present claims 2-41 thereby overcoming each of the of the rejections of these claims.

The Examiner is therefore respectfully requested to reconsider the rejection of claims 1-41.

In view of the above amendments and remarks, allowance of all claims pending is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney.

Respectfully submitted,



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